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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,069	08/30/2006	Johann Doppstadt	P71396USD	5905
136 7590 06/24/2009 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			EXAMINER KATCOFF, MATTHEW GORDON	
			ART UNIT 4137	PAPER NUMBER
			MAIL DATE 06/24/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,069

Applicant(s)

DOPPSTADT ET AL.

Examiner

Matthew G. Katcoff

Art Unit

4137

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/30/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 12/08/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 12/08/2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Response to Amendment

2. The amendment filed on 08/30/2006 is accepted. Claims 1-30 are cancelled and new claims 31-50 are accepted.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "2" has been used to designate both a tooth on page 9, line 5 and a knife on page 9, lines 7 and 23. Further, reference character "8/1 and 8/2" have been used to designate both top surface supporting surface on page 9, line 5 and placing surfaces on page 10, line 8.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: Claim 38 has the phrase "the side surfaces of the tooth body taper off diagonally upward, **taper, respectively** taper off..." the bolded terms are unclear. In claim 39, the phrase "knife receiving device the outside radius" is missing a term between the words "device" and "the" and the term respectively in line 7 should be changed.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 31, 33-34, 37, 40-42, 45 and 47-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning claim 31, it is unclear if the knife receiving device is a separate part of the knife holder or part of the tooth body. It is also unclear what limitation the phrase "in such a way that recess surfaces occur" (line 8) provides. Further the terms wedge shaped and conically (line 7) are indefinite.

Concerning claim 33, the term "cylinder like" (line 6) is indefinite.

Concerning claim 34, the terms wedge like and conically (lines 3-4) are indefinite.

Concerning claim 37, it is unclear what limitation the term "preferred diameter" (line 6) provides.

Concerning claim 40, it is unclear how the tooth body can cut the radius of the cylinder and further it is unclear what cylinder is being referenced.

Concerning claim 41, the terms "preferably" (line 4), conically (line 5) and "wedge like" (line 6) are indefinite.

Concerning claim 42, the terms conically and "wedge like" (line 3) are indefinite.

Concerning claim 45, the terms "preferably" (lines 3 and 5) is indefinite.

Concerning claims 47 and 48, it is unclear which element of the knife holder the "first cutting body and a second cutting body" modify or are added to.

It is further unclear the relation between these cutting bodies and the tooth body and knife.

8. Claim 48 recites the limitation "the first and second cutting body is disc like" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.
9. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "tooth body" in claims 31-43 is used by the claim to mean "tooth holder", while the accepted meaning is "tooth holder." The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 49-50 are rejected under 35 U.S.C. 102(b) as being anticipated by E.P. Patent Application No. 0771911 A1 to Gelai (*Gelai*).

Concerning claim 49, *Gelai* discloses in figure 1 a comminution device (2) with multiple knife holders (12).

Concerning claim 50, *Gelai* discloses in figure 8 a number of knife holders (40) which are arranged on the comminution cylinder (300) in a staggered manner.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 31-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over D.E. Patent No. 20116344U to Pizzuto (*Pizzuto*) which is directly translated by U.S. Patent Application No. 2005/0001084 A1 in view of *Gelai*.

Concerning claim 31, *Pizzuto* discloses, in figure 7 below, a knife holder comprising a tooth body (E1) which is capable of being fastened on a cylinder due to it's shape and a knife body (10) which is able to be attached to the tooth body in a positive locking manner through the knife receiving device (60) which is a recess which is wedge shaped. *Pizzuto* does not disclose the receiving device having a J shape.

Gelai, a support for a milling tool, discloses in figure 2 a knife receiving device (12) having a J shape.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to add *Gelai's* J shape knife receiver to *Pizzuto's* knife holder because this is a simple substitution one receiving structure for another.

Concerning claim 32, *Pizzuto* discloses the knife (18) is attached to the tooth body (E1) in a fixed, releasable way. The further limitation of at least part of the knife can be put in the holder is an alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 33, *Pizzuto* discloses the knife holder (60) is at the front end of the tooth body (E1) in the direction of the cutting (see page 2, ¶21, lines 7-8). The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 34, *Pizzuto* discloses the tooth body (E1) supports the knife flange sides (12 and 58) and an elevation (60). The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 35, *Pizzuto* discloses in figure 7 the tooth body (E1) and the knife (18) have shapes which correspond. The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 36, *Pizzuto* discloses in figure 7 the tooth body (E1) has on its bottom surface (E2) a centering device which is the curved part of the bottom surface which centers the holder on the commutation cylinder. The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 37, *Pizzuto* discloses the tooth body (E1) and the knife (18) have a fastening means (64) which is fixed and releasable. The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 38, *Pizzuto* discloses the knife is made of metal (page 2, ¶ 20, line 9). The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 39, *Pizzuto* discloses in figure 7 the outer radius of the tooth body cuts on its side opposite the knife receiving device (60) which is also the outside radius of the comminuting cylinder. The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 40, *Pizzuto* discloses the knife is designed as a tooth (18 and 16) and the tooth has a radius (38) on its side opposite the tooth body (E1) which cuts along the radius of the cylinder which the tooth body is attached. The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 41, *Pizzuto* discloses the tooth (18), which is wider than the tooth body (E1) has a support region (56) which is supported by the supporting body of the tooth body (60) and the support surfaces (50 and 58) run conically and are wedge like.

Concerning claim 42, the structural limitations claimed are encompassed by claim 41 since the recess (56) and flat section (68) are designed such that the

knife is centered on the tooth body (E1); thus claim 42 is rejected for at least the same reasons as claim 41 above is rejected.

Concerning claim 43, while *Pizzuto* does not disclose two surfaces of the knife facing the tooth body and oriented downward to the recess, the combination of *Pizzuto's* tooth body with a J shaped recess disclosed by *Galai* in claim 31 would have to have had this structure in so that the knife could mate with the tooth body.

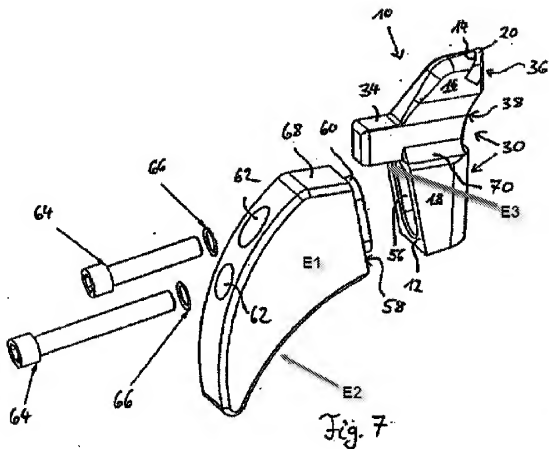
Concerning claim 44, while *Pizzuto* does disclose the surface facing the tooth body oriented downward (68) which are recess counter faces which corresponds with the knife, *Pizzuto* does not disclose that this surface is inclined. However it would have been obvious to a person of ordinary skill in the art at the time of the invention to make this surface have an incline since there are only a few ways to mate the knife and the tooth body and thus it would have been obvious to try.

Concerning claim 45, *Pizzuto* discloses the tooth (18) has a knife edge (20) which is made of two hard metal parts. The further limitations are alternative structural limitation and thus not necessary for rejection purposes.

Concerning claim 46, the structural limitations claimed are encompassed by claim 45; thus claim 46 is rejected for at least the same reasons as claim 45 above is rejected.

Concerning claim 47, *Pizzuto* discloses a first cutting body (12) and a second cutting body (36) where the first cutting body is flat and planar.

Concerning claim 48, *Pizzuto* discloses both cutting bodies are disc like since they each are planar.



14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew G. Katcoff whose telephone number is (571) 270-1415. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G. K./
Examiner, Art Unit 4137
06/22/09

/Gary Jackson/
Supervisory Patent Examiner
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